



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,448	12/18/2000	Jerome Dale Johnson	O14-012-02-US	3475

54092 7590 04/21/2006

NORTH OAKS PATENT AGENCY
45 ISLAND ROAD
NORTH OAKS, MN 55127

EXAMINER

PASS, NATALIE

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/739,448	JOHNSON ET AL.	
	Examiner	Art Unit	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 20-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 20-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>15 June 2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7 April 2006 has been entered.

2. This communication is in response to the Request for Continued Examination and amendment filed 7 April 2006. Claim 11 has been amended. Claims 12-19 have been cancelled. Claims 1-11, 20-49 remain pending. The IDS filed 15 June 2005 has been entered and considered.

Specification

3. The objection to the specification under 35 U.S.C. § 132 is hereby withdrawn due to the amendment filed 7 April 2006.

Claim Objections

4. The objection to claims 11-14 under 37 CFR 1.75(c), for being of improper dependent form is hereby withdrawn due to the amendment filed 7 April 2006.

Art Unit: 3626

Claim Rejections - 35 USC § 112

5. The rejection under 35 U.S.C. § 112, first paragraph is hereby withdrawn due to the amendment filed 7 April 2006.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-11, 20-27, 30-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood, U.S. Patent Number 4, 567, 359 in view of Warady, U.S. Patent Number 6, 067, 522.

(A) As per claim 1, Lockwood teaches a method for generating a customized proposal in the development of insurance plans for a customer (Lockwood; column 6, lines 3-11), the method comprising steps of:

storing customer data within a database in a computer system the “memory” (reads on “database”) having stored therein “information on insurance policies and prices for various insurance companies” (reads on “insurance plan products”) (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 37 to

column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

presenting a description of insurance plan options available to the customer on a “terminal” (reads on “display device of the computer system”) (Lockwood; column 3, lines 9-48, column 6, lines 5-11) based upon the stored customer data and user selected plan options obtained from an input device of the computer system (Lockwood; column 3, lines 9-48, column 6, lines 12-16), (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30); and

generating a customized proposal in the computer system based upon a selection made from the presented insurance plan options that includes a description of an insurance plan (Lockwood; column 3, lines 9-48, column 6, lines 17-32), at least a portion of the customer data, and estimated costs for the insurance plan (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

Lockwood fails to explicitly disclose

the description of insurance plan options including an indication that a plan may be offered but is not currently available to the customer based upon the plan requirements data and either other selected plan options or the customer data.

However, the above features are well-known in the art, as evidenced by Warady.

In particular, Warady teaches

the description of insurance plan options including an indication that a plan may be offered but is not currently available to the customer based upon the plan requirements data and either other selected plan options or the customer data (Warady; Figure 7e, column 4, line 51 to column 5, line 5, column 5, line 65 to column 6, line 5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lockwood to include the description of insurance plan options including an indication that a plan may be offered but is not currently available to the customer based upon the plan requirements data and either other selected plan options or the customer data, as taught by Warady, with the motivations of enabling enrollment forms that are customized for each employee on an individual basis, providing a system that manages health and welfare benefit enrollment information, that can communicate the information to interested parties such as, for example, participating employees and plan providers, and produce the billings needed for each plan provider's premiums and/or fees, and reduce time wasted and human error by employers and employees implementing and administering health and welfare benefit plans (Warady, column 1, lines 44-45, 57-61, column 2, lines 35-45).

(B) As per claims 2-5, Lockwood and Warady teach a method as analyzed and discussed in claim 1 above:

further comprising a step of printing the customized proposal (Lockwood; column 7, lines 5-24);

wherein the generating step comprises providing insurance company data as part of the customized proposal (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column

2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

further comprising a step of providing the customized proposal in electronic form to the customer (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30); and

wherein the generating step comprises deriving the estimated costs from information sorted in the database (Lockwood; column 3, lines 9-48, column 6, lines 17-32).

(C) As per claims 6-8, Lockwood and Warady teach a method as analyzed and discussed in claim 1 above:

wherein the presenting step comprises determining if an offered plan is available to the customer based upon the user selected plan options or the customer data (Lockwood; column 3, lines 9-48, column 6, lines 17-32), (Warady; column 4, line 51 to column 5, line 5, column 5, line 65 to column 6, line 5);

wherein the indication that a plan may be offered but is not currently available to the customer comprises conditions which are not met for the customer to qualify for the offered but currently not available insurance plan (Warady; Figure 7e, column 4, line 51 to column 5, line 5, column 5, line 65 to column 6, line 5);

wherein the presenting step comprises:

selecting, with the input device (Lockwood; column 6, lines 3-4) one or more sets of possible insurance plans from the insurance plan options presented to the customer on the display device (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line

Art Unit: 3626

60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

determining an estimated cost for each of the selected sets of insurance plans (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30); and

generating a customized comparison for the possible set of insurance plans in the sales computer system that includes the customer data, the description of the selected insurance plans, and the estimated costs for the selected set of insurance plans (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 above, and incorporated herein.

(D) As per claims 9-10, Lockwood and Warady teach a method as analyzed and discussed in claim 1 above

wherein the available insurance plan options comprise a plurality of health insurance plans (Lockwood; column 3, lines 32-36);

further comprising a step of transmitting the customer data and the user selected plan options from the computer system to a remote server system for processing of a request for insurance (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60,

Art Unit: 3626

column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

(E) Claim 11 differs from method claim 1 by reciting a “computer program product readable by a computer system ... ” in the preamble. As per this limitation, Lockwood clearly discloses his invention to be implemented on a computer program product readable by a computer system ... (Lockwood; Figure 1, column 2, lines 8-18, 34-46). The remainder of claim 11 repeats the limitations of claim 1, and is therefore rejected for the same reasons given above for claim 1.

The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 above, and incorporated herein.

(F) As per claims 20-23, Lockwood and Warady teach a method as analyzed and discussed in claim 1 above

wherein the generating step comprises providing an insurance plan as part of the customized proposal (Lockwood; column 3, lines 9-48, column 6, lines 17-32);

wherein the generating step comprises gathering “predetermined customer information” (reads on providing insurance application forms”) as part of the customized proposal (Lockwood; column 3, lines 15-16);

wherein the generating step comprises providing “a series of quotations from various institutions... purchaser can compare quotations” (reads on “benefit charts data”) as part of the customized proposal. (Lockwood; column 3, lines 32-33); and

Art Unit: 3626

wherein the generating step comprises providing provider information data as part of the customized proposal (Lockwood; column 7, lines 5-12).

(G) As per claims 24-27, Lockwood and Warady teach a method as analyzed and discussed in claim 1 above

wherein the available insurance plan options comprise a plurality of dental insurance plans (Warady; column 4, lines 1-19);

wherein the available insurance plan options comprise a plurality of life insurance plans (Warady; column 4, lines 1-19);

wherein the available insurance plan options comprise a plurality of disability insurance plans (Warady; column 4, lines 1-19);

wherein the insurance plan comprises a set of insurance plans (Warady; column 4, lines 1-19).

The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 above, and incorporated herein.

(H) Claim 30 differs from method claim 1, in that it is a system rather than a method for generating a customized proposal in the development of insurance plans for a customer.

System claims 30-47 repeat the subject matter of claims 1-3, 20-23, 4-7, 8-9, 24-26, 10, and 27 respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 1-3, 20-23, 4-7, 8-9, 24-26, 10, and 27 have been shown to be fully disclosed or obvious by the collective teachings of Lockwood and Warady in the above rejection of claims

Art Unit: 3626

1-3, 20-23, 4-7, 8-9, 24-26, 10, and 27, it is readily apparent that the system disclosed collectively by Lockwood and Warady includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1-3, 20-23, 4-7, 8-9, 24-26, 10, and 27, and incorporated herein.

8. Claims 28-29, 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood, U.S. Patent Number 4, 567, 359 and Warady, U.S. Patent Number 6, 067, 522, as applied to claim 1 above, and further in view of Gamble, et al., U.S. Patent Number 6, 163, 770 for substantially the same reasons given in the prior Office Action (paper number 09292005). Further reasons appear hereinbelow..

(A) As per claim 28, Lockwood and Warady teach a method as analyzed and discussed in claim 1 above comprising

wherein the storing step comprising storing the customer data and insurance plan products in a “memory” (reads on “database”) that is hosted in a networked environment (Lockwood; column 2, lines 34-46) with portions stored in a remote memory storage device (Lockwood; column 2, lines 51-54).

Lockwood and Warady fail to explicitly disclose a relational database.

However, the above features are well-known in the art, as evidenced by Gamble.

In particular, Gamble teaches wherein the storing step comprising storing the customer data and insurance plan products in a relational database (Gamble; column 14, lines 34-52).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lockwood to include this limitation, as taught by Gamble,

Art Unit: 3626

with the motivations of generating documentation for insurance policies and of efficiently calculating changes in a claims costs and generating printed insurance documentation (Gamble, column 5, line 58 to column 6, line 46).

The motivations for combining the respective teachings of Lockwood and Warady are as given in the rejection of claim 1 above, and incorporated herein.

(B) As per claim 29, Lockwood, Warady and Gamble teach a method as analyzed and discussed above comprising

wherein the storing step comprising storing the customer data and insurance plan products in a relational database (Gamble; column 14, lines 34-52) comprising a plurality of modules (Warady; Figure 1, column 8, lines 20-35).

The motivations for combining the respective teachings of Lockwood, Warady and Gamble are as given in the rejections of claims 1 and 28 above, and incorporated herein.

(C) Claims 48-49 differ from method claims 28-29 in that they recite a system rather than a method for generating a customized proposal in the development of insurance plans for a customer.

System claims 48-49 repeat the subject matter of claims 28-29 respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 28-29 have been shown to be fully disclosed or obvious by the collective teachings of Lockwood, Warady and Gamble in the above rejection of claims 28-29, it is readily apparent that the system disclosed collectively by Lockwood, Warady and Gamble includes the apparatus to perform these

Art Unit: 3626

functions. As such, these limitations are rejected for the same reasons given above for method claims 28-29, and incorporated herein.

Response to Arguments

9. Applicant's arguments filed 7 April 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 7 April 2006.

(A) At paragraph 2 at page 10 of the 7 April 2006 response, Applicant points out that the Information Disclosure Statement has now been scanned into the PALM/PAIR system. Examiner thanks Applicant for noting this, and has accordingly reviewed and considered the IDS filed 15 June 2005.

(B) At paragraph 3 at page 10 of the 7 April 2006 response, Applicant asserts that claims 1 and 30 do not contain new matter. Applicant's arguments are persuasive, and Examiner has accordingly withdrawn the objection under 35 U.S.C. 132 and the rejections under 35 U.S.C. 112, first paragraph.

(C) At paragraph 4 at page 10 of the 7 April 2006 response, Applicant notes the amendment and changes to claim 11. Applicant's arguments are persuasive; consequently, Examiner has withdrawn the objections to claims 11 and 13 under 37 CFR 1.75(c).

(D) At pages 11-12 of the 7 April 2006 response Applicant argues that the features in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including the newly added limitations of the amendment filed 7 April 2006, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Lockwood, Warady and Gamble, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 09292005), and incorporated herein. In particular, Examiner notes that the recited features of presenting on a "display device" a "description of insurance plan options including an indication that a plan may be offered but is not currently available to the customer based upon the plan requirements data and either other selected plan options or the customer data" are taught by the combination of applied references (Warady; Figure 7e, column 4, line 51 to column 5, line 5, column 5, line 65 to column 6, line 5). Please note that Examiner interprets Warady's teachings of "prerequisites table 110 stores information describing which benefit plans, if any, described in the benefit tables 100 have prerequisites that must be met before an employee can be enrolled in the plans. For example, certain life insurance plans require evidence of insurability of an employee to be approved by the plan provider before the employee is eligible to receive the chosen benefit or level of coverage. In this example, the prerequisites table 110 could store information describing the conditions under which evidence of insurability is required by the plan provider" (Warady; column 5, line 65 to column 6, line 7) as teaching presenting on a "display device" a "description of insurance plan options including an indication

that a plan may be offered but is not currently available to the customer based upon the plan requirements data and either other selected plan options or the customer data." As such, it is unclear as to how or why Applicant's claimed limitations are not met by at least the aforementioned passages. Perhaps Applicant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references Schotz, U.S. Patent Number 4, 837, 693, Provost, et al., U.S. Patent Number 6, 341, 265, Peterson et al., U.S. Patent Number 6, 343, 271, Spurgeon, U.S. Patent Number 5, 890, 129, Joao, U.S. Patent Application Publication Number 2002/0032583, Bosco, et al., U.S. Patent Number 5, 191, 522, Meyer, et al., U.S. Patent Number 5, 907, 828, Borghesi et al., U.S. Patent Number 5, 950, 169 teach the environment of electronically configuring and processing of insurance documents.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the communication
and do NOT sign the communication.

After Final communications should be labeled "Box AF."

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Natalie A. Pass

April 14, 2006


C. LUKE GILLIGAN
PATENT EXAMINER